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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/763,822

International Application No. : PCT/EP99/06302

Applicants : Thorvald Eelco Wallaart et al.

Filed : April 24, 2001

Title : TRANSGENIC AMORPHA-4, 11-DIENE
SYNTHESIS

Group Art Unit : 1652

Examiner : Tekchand Saidha

Confirmation No. : 3747

Customer No. : 28289

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTION WITH TRAVERSE

Sir:

This is in response to the Office Action dated April 22, 2004 in which the Examiner required a restriction to one of the following inventions:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 21, 2004.

Helen Gerace
(Name of Person Mailing Paper)

Helen Gerace May 21, 2004
Signature Date

Group I: claims 43-65 and 75-86, drawn to DNA (SEQ ID NO: 13 or Figure 12) encoding amorphadiene synthase (or amorpha-4, 11-diene synthase), vector, host cell and method of making the synthase recombinantly; classified in class 435, subclass 232.

Group II: claims 66-67, drawn to a polypeptide having amorphadiene synthase (or amorpha-4, 11-diene synthase) activity; classified in class 435, subclass 232.

Group III: claims 68 and 70, drawn to a method of preparing amorphadiene or artemisinin using amorphadiene synthase (or amorpha-4, 11-diene synthase); classified in class 435, subclass 4.

Group IV: claims 69 and 71-74, drawn to a method of preparing amorphadiene or artemisinin using DNA of SEQ ID NO: 13 encoding amorphadiene synthase (or amorpha-4, 11-diene synthase); classified in class 435, subclass 41.

Because the Examiner has required election of a single group for prosecution, Applicants provisionally elect to prosecute Group I with traverse for the following reasons.

Applicants respectfully disagree that the application contains four patentably distinct inventions because the single technical inventive feature that links all of the claims is DNA of SEQ ID NO: 13. In particular, Groups I and II contain claims that either directly or indirectly recite DNA of SEQ ID NO: 13 that encodes a polypeptide having the biological activity of amorphadiene synthase; and Groups III and IV contain claims that recite methods for preparing amorphadiene or artemisinin that either directly or indirectly use DNA of SEQ ID NO: 13 that encodes amorphadiene synthase. Thus, the distinguishing feature of all of the claims is DNA of SEQ ID NO: 13.

Additionally, all four groups are classified in the same class and two of the four groups share the same subclass as well. Thus, there would be no serious burden on the Examiner to examine all of the claims in a single application. Furthermore, Applicants contend that even those claims that are not classified in the same subclass would not place an undue burden on the Examiner because, based on the fact that the special technical feature of all of the claims is SEQ ID NO: 13, examination of claims in

Application No. 09/763,822
Paper dated May 21, 2004
In response to USPTO correspondence of April 22, 2004
Attorney Docket No. 702-010272

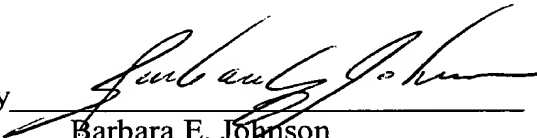
one group is believed to be coextensive with the examination of claims of the other groups.

Finally, Applicants contend that even if there is more than one distinct invention in the application, the burden on the Patent Office to examine groups of claims that are so closely linked would be much less than the burden on Applicants in prosecuting multiple applications.

Based on the foregoing, Applicants respectfully request rejoinder of the remaining groups inclusive of Groups I through IV.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
ORKIN & HANSON, P.C.

By 

Barbara E. Johnson
Registration No. 31,198
Attorney for Applicants
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com



TRANSMITTAL LETTER

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application No.: 09/763,822 Filing Date: April 24, 2001
Examiner: Tekchand Saidha Group Art Unit: 1652
Invention: TRANSGENIC AMORPHA-4, 11-DIENE SYNTHESIS

Transmitted herewith is an Election with Traverse in the above-identified application.

- ☐ Small entity status is asserted for this application under 37 CFR 1.27.
☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.
☒ No additional fee is required.
☐ The fee has been calculated as shown below:

No. of Claims after Election	Highest No. Previously Paid For	Present Extra		Small Entity Rate	Non-Small Entity Rate	Charge
Total <u>44</u>	<u>44</u>	<u>-0-</u>	x	\$9.00	\$18.00	\$ <u>-0-</u>
Indep. <u>14</u>	<u>14</u>	<u>-0-</u>	x	\$43.00	\$86.00	\$ <u>-0-</u>
First Presentation of Multiple Dependent Claims				+\$145.00	+\$290.00	\$ <u>-0-</u>
				TOTAL ADDITIONAL FEE		\$ <u>-0-</u>

- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650. An original and two copies of this sheet are enclosed.
- ☒ Any additional filing fees required under 37 CFR 1.16.
- ☒ Any patent application processing fees under 37 CFR 1.17.

May 21, 2004

Date

By

Barbara E. Johnson

Registration No. 31,198

Attorney for Applicants

436 Koppers Building

436 Seventh Avenue

Pittsburgh, PA 15219-1818

Telephone: (412) 471-8815

Facsimile: (412) 471-4094

E-mail: webblaw@webblaw.com

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